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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,188	01/10/2001	Silvio Salom	ADC-501	2770

7590 05/15/2003
Aliko K. Collins
215 Grove St.
Newton, MA 02466

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/759,188

Applicant(s)

SALOM, SILVIO

Examiner

Tan Dean Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 10-19, 20-22, 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over R1 (Orbit article) alone or further in view of Article SmartPatents or R2 (Article of 7/1999 "Entrepreneurs ...in Oxford").

R1 discloses a method a business system for forming a new created enterprise comprising the steps of a) forming a holding company comprising of previously existing enterprises, developing intellectual property (IP) assets comprising key technologies within the existing enterprises, inherently depositing IP assets in a common database, developing new products and market opportunities for at least one of the developed IP assets within at least one of the existing enterprises, and deciding whether to form the new enterprise based on the developed new products and market opportunities for the at least one of the IP assets and executing the formation of a new enterprise (bringing to market) (see abstract). As for steps of securing financing and provide management resources for the new enterprise, these are well known needs for new/startup company to form and survive and thrive and would have been obvious to a person of ordinary skill in the art.

Article SmartPatents is cited to teach a system for assisting firms in protecting and optimizing use of IP for profitability by merging IP/patents with finance, sales, manufacturing, and management resources in order to license, trade, or sell IP/patents for profitability. It would have been obvious to modify the process of R1 by using the provision of Article SmartPatents to secure financing and provide management resources for the new enterprise.

R2 is cited to teach the common issues facing a new or start-up company such as securing sufficient financing and banking for the forming of a new business, providing management resources for the new enterprise, finding business premises, maintaining intellectual property (IP) and legal issues, accounting and insurance. It would have been obvious to modify the process of R1 by using the provision of R2 to secure financing and provide management resources for the new enterprise.

As for claims 2, 10, 22, 30, these are taught in R1. As for claim 11, the various financial parameters for forming a successful or profitable new enterprise are relative and depends on desired target and would have been to a skilled artisan. As for claim 21, this is taught in Article SmartPatents. As for claims 12, 31, these are fairly taught in R1 as R1 discloses the steps of devising commercial applications to be taken to the market through licensing or joint venture partners. As for claims 13, 32, these are inherently included in R1 since the partners are national corporations. Alternatively, it would have been obvious to form partners internationally to provide global service. As for claims 14, 33, these are inherently included in R1 since it identifies, develops and acquires existing key technologies within the company and new technologies from

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outside the companies which occur frequently and/or on a repeatable basis. As for claims 15, 34, these are inherently included in R1 for a successful marketing and commercializing effort. As for claims 16-17, 35-36, since it's well known that many academic institution such as Stanford or MIT continuously provide academic researches has great potential commercial technologies, it would have been obvious to partner with the academic institutions to reap the benefits of obtaining new technologies. As for claims 18, 37, these are well known and obvious in the commercial business to encourage innovation by rewarding those who increase intellectual capital such as patents, new technology, etc. As for claims 19, 38, these are inherently included/obvious for supporting/maintaining a new/startup enterprise.

3. Claims 1-2, 10-19, 20-22, are rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over R1 (Orbit article) in view of R3 (Pegasus article) and Article SmartPatents.

The teaching of R1 is cited above. R3 is cited to teach the concept of forming a new enterprise comprising the steps of: a) forming a holding company comprising of previously existing enterprises, covering intellectual property (IP) assets under the new holding company, wherein the reorganization increase the flexibility to pursue new activities and initiatives through the new company rather than through the existing company (see abstract). It would have been obvious to modify the process of R1 with R3 to increase the flexibility to pursue new activities and initiatives through the new company.

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Article SmartPatents is cited to teach a system for assisting firms in protecting and optimizing use of IP for profitability by merging IP/patents with finance, sales, manufacturing, and management resources in order to license, trade, or sell IP/patents for profitability. It would have been obvious to modify the process of R1 by using the provision of Article SmartPatents secure financing and provide management resources for the new enterprise.

As for claims 2, 10, 22, 30, these are taught in R1. As for claims 12, 31, these are fairly taught in R1 as R1 discloses the steps of devising commercial applications to be taken to the market through licensing or joint venture partners. As for claims 13, 32, these are inherently included in R1 since the partners are national corporations. Alternatively, it would have been obvious to form partners internationally to provide global service. As for claims 14, 33, these are inherently included in R1 since it identifies, develops and acquires existing key technologies within the company and new technologies from outside the companies which occur frequently and/or on a repeatable basis. As for claims 15, 34, these are inherently included in R1 for a successful marketing and commercializing effort. As for claims 16-17, 35-36, since it's well known that many academic institution such as Stanford or MIT continuously provide academic researches has great potential commercial technologies, it would have been obvious to partner with the academic institutions to reap the benefits of obtaining new technologies. As for claims 18, 37, these are well known and obvious in the commercial business to encourage innovation by rewarding those who increase intellectual capital

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such as patents, new technology, etc. As for claims 19, 38, these are inherently included/obvious for supporting/maintaining a new/startup enterprise.

4. Claims 3-9, 19, 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over R1 as applied to claims 1-2, 10-19, 20, 22, 30-38 above, and further in view of Article SmartPatents Business Decision System.

The teaching of R1 is cited above. Article SmartPatents is cited to teach a system for assisting firms in protecting and optimizing use of IP for profitability by merging IP/patents with finance, sales, manufacturing, and management resources in order to license, trade, or sell IP/patents for profitability. It would have been obvious to modify the process of R1 by using the provision of Article SmartPatents to protect and optimize use of IP for profitability.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent:

a) US 2001/0042034 discloses a method of repeatedly securizing IP assets and facilitating investments therein.

b) US 2002/0046038 discloses a system and method for establishing value and financing of IP.

2) Foreign: Article "A View from Buenos Aires" discloses the the view of whether a holding company or an operating company should own Intellectual properties.

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1. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
May 12, 2003



DEAN T. NGUYEN
PRIMARY EXAMINER